

REMARKS

Claims 1-38 are pending in the present application. Claims 9, 10 and 13-38 have been allowed. Claims 1-4 and 7 have been amended and new Claims 39-45 have been added by this Amendment.

I. Submission of IDS and Form PTO-1449

At paragraph 2 of the previous 10/6/03 Office Action it is indicated that the Information Disclosure Statement filed 8/2000 did not include a listing of the cited patents. A copy of the 8/2000 IDS was included with the 1/5/2004 Response along with a newly prepared form PTO-1449, however, the 3/22/04 Office Action does not acknowledge that IDS. Thus attached is another copy of the 8/2000 IDS form PTO-1449 listing the cited patents.¹ It is requested that the patents listed on the form PTO-1449 be considered and made of record. Though it is submitted that no fee is required for the subsequent submittal of the form PTO-1449 since the IDS and copies of cited patents were timely submitted, authorization is given to charge PSC Inc.'s deposit

¹ Though the stamped return postcard (copy attached) indicates that the 8/2000 IDS included the form PTO-1449 and copies of U.S. patent documents (2), applicant's file did not include a copy of the form but only copies of the IDS and two patents cited.

account no. 13-4953 for any fee required to enable consideration of this IDS.

II. Response as to Rejection of Claims 1-8, and New Claim 39

Claims 1-4 and 7 have been rejected under 35 U.S.C. § 103 over Sato 6,084,524 in view of Kurimoto EP 0323848; claims 5, 6 and 8 have been rejected under 35 U.S.C. § 103 over Sato 6,084,524 in view of Kurimoto EP 0323848, further in view of Pantus 5,831,529. These rejections are respectfully traversed.

Claim 1 has been amended and includes the steps of

illuminating an object located in front of a specific portion of a window with light from a light source;

detecting an amount of light from the light source that has been reflected by the object;

determining whether an object is present or absent from immediately in front of the specific portion of the window by comparing the amount of light detected in the detecting step to an amount of light expected when an object is present in front of the specific portion of the window.

By contrast, neither Sato '524 nor Kurimoto EP'848 disclose determining whether an object is present or absent from

immediately in front of the specific portion of the window. In a preferred embodiment, such a method (such as for example in new Claim 39) allows an operator to place a hand next to a marked spot (an active region) of the window which then serves as a switch for initiating a data reader control function.

Therefore it is submitted that Claim 1 as amended is non-obvious and allowable over the items of record. It is also submitted that dependent Claims 2-8 and 39 provide additional distinguishing limitations and should also be allowable.

III. Response as to Rejection of Claims 11-12

Claims 11 and 12 have been rejected under 35 U.S.C. § 103 over Sato 6,084,524 in view of Kurimoto EP 0323848. This rejection is respectfully traversed.

Claims 11-12 are directed to a method of controlling a data reader including (among others) the step of "determining whether the window is present." In explaining the rejection of Claim 11, the Office Action refers to Sato '524 (at col. 2 lines 1-6) as disclosing "detecting surface state." There is no disclosure in Sato '524 or discussion in the Office Action as to how "detecting a surface state" equates to the claim limitation of "determining whether the window is present." Thus it would

appear that the Office Action infers that it would be obvious to modify "detecting surface state" into "determining whether the window is present." There is however no statement identifying any motivation or suggestion for such modification. Of course, a reference must provide the actual suggestion to modify. See, In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) citing In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) (examiner can satisfy burden of obviousness in light of combination "only by showing some objective teaching [leading to the combination]"). Therefore this rejection is respectfully traversed and the Examiner is requested to cite a reference disclosing this feature or the rejection removed. See, M.P.E.P. § 706.02(j), 2143.01.

Secondly, Claim 11 includes the step of "disabling the data reader if it is determined, in the determining step, that the window is not present." Neither Sato '524 nor Kurimoto EP'848 discloses such a step. Further, the 3/22/04 Office Action does not address this limitation. None of the cited patents disclose such a limitation or suggest its advantages. Therefore this rejection is respectfully traversed and the Examiner is requested to cite a reference disclosing this feature or the rejection removed. See, M.P.E.P. § 706.02(j), 2143.01.

Thus it is submitted that a *prima facie* case of obviousness has not been made as to Claims 11-12 as the cited patents disclose neither the step (1) "determining whether the window is present" nor the step (2) "disabling the data reader if it is determined, in the determining step, that the window is not present."

Claim 12 provides the further limitation wherein "the step of disabling the data reader comprises turning the laser off." There is no suggestion in the cited patents to "turning the laser off" if it is determined that the window is not present.

Therefore it is submitted that Claims 11-12 are non-obvious and allowable.

IV. New Claims 40-45

New Claim 40 includes the steps of (among others):

- detecting an amount of light from the light source that has been reflected by the object;

- determining whether the amount of light detected exceeds a first threshold and initiating a first data reader control function if it is determined that the first threshold is exceeded;

- determining whether the amount of light detected exceeds a second threshold and initiating a second data reader control function if it is determined that the second threshold is exceeded.

None of the cited patents disclose such a method of using first and second thresholds for initiating first and second reader functions. Thus it is submitted that Claim 40 should be allowable. Dependent Claims 41-45 provide additional limitations and should also be allowable.

V. Conclusion

Therefore it is respectfully submitted that Claims 1-45 are allowable and a Notice of Allowance is earnestly solicited.

Respectfully submitted,

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By: John A. Rafter, Jr.
John A. Rafter, Jr.
Reg. No. 31,653

Customer No 33451
STOEL RIVES LLP
900 SW Fifth Avenue, Suite 2600
Portland, OR 97204-1268
Telephone: (503) 224-3380
Facsimile: (503) 220-2480
Attorney Docket No. 51306/667

Attached: Copy of 8/2000 IDS w/ Form PTO-1449